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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/738,659 10/30/96 MOTOYAMA

T 5244-051-2X-

EXAMINER

022850 TM02/0730
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ART UNIT, PAPER NUMBER

DATE MAILED

41

2152

07/30/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 05/11/2001, 05/23/2001, 05/31/

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 10, 12-19, 36, 38-44, 52-61, 68-87 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 10, 12-19, 36, 38-44, 52-61, 68-87 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Disclosure Statement(s), PTO-1449, Paper No(s). 31-60
Summary, PTO-1449

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

1. Claims 10, 12-19, 36, 38-44, 52-61, and 68-87 are presented for examination.
2. The following is a quotation of 35 U.S.C. § 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 10, 12-19, 36, 38-44, 52-61, and 68-87 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kraslavsky et al (Kraslavsky)** patent no. **5,537,626**, in view of **Cohn et al (Cohn)** patent no. **5,740,231**.
4. **Kraslavsky** and **Cohn** were cited as prior art in the last office action.
5. As to claims 10 and 68, Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a monitored device (printer 4, figure 1) and a monitoring device (NTWK ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined

using sensors within the monitored device (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35. In addition, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11); and

transmitting the information as a message from the monitoring device to the monitored device through one or more LANs in Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is being transmitted as an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message format to communicate (transmit and receive) between Kraslavsky's monitored and monitoring devices because it would allow the message to be transferred globally between any devices (devices that are taught in Kraslavsky and Cohn's references).

6. As to claims 12-13, Kraslavsky teaches transmitting the information to the monitored device which is a business office device such as copier, facsimile machine, or printer (Abstract, and col. 2 lines 35-62).
7. As to claim 14, Kraslavsky and Cohn teach receiving the transmitted information by the monitored device; and transmitting, through the Internet, an Internet electronic mail message from the monitored device to the monitoring device containing status information of the monitored device, in response to the transmitted information from the monitoring device (Kraslavsky, col. 2 lines 35-62, col. 4 lines 3-14, col. 7 lines 38-63; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).
8. As to claim 15, Kraslavsky teaches transmitting the information from the monitoring device to a plurality of monitored devices including the monitored device (col. 34 lines 63-67).
9. As to claims 52-53, Cohn inherently teaches Internet electronic mail message includes an "@" symbol followed by a domain name, and a description of an encoding type of the Internet electronic mail message. This information is also admitted by applicant as well known.

10. As to claim 54, Kraslavsky and Cohn teach the invention substantially as claimed as discussed above; however, they do not explicitly teach using a firewall. Official Notice is taken that firewall is well known in Data Processing Art. It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to use a firewall in Kraslavsky and Cohn's network because it would not allow communication between the monitor device and the machine if message do not satisfy filter conditions in the firewall.

11. As to claims 55-56, they have similar limitations as claims 52-53; therefore, they are rejected under the same rationale as discussed above.

12. As to claims 72-73, Kraslavsky and Cohn teaches transmitting the Internet electronic mail message through a Local Area Network without using a telephone line (Kraslavsky, col. 2 lines 35-58; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

13. As to claims 74-75, they have similar limitations as claims 72-73; therefore, they are rejected under the same rationale as discussed above.

14. As to claims 16 and 69, Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a machine and a monitoring device, comprising the steps of:

determining status information using at least one of a mechanical and electrical sensor (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11); and

transmitting the status information from the machine to the monitoring device through one or more LANs in Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is being transmitted as an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message format to communicate (transmit and receive) between Kraslavsky's machine and monitoring device because it would allow message to be transferred globally between any machine and device.

15. As to claim 17, Kraslavsky and Cohn teach analyzing the status information by the machine, wherein the status information is transmitted as the Internet electronic mail

message from the machine when the status information is analyzed and determined to be within a standard operating range (Kraslavsky, col. 39 lines 20-54; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

16. As to claim 18, Kraslavsky and Cohn teach determining status information which is outside of normal operating parameters exists in the machine using at least one of the mechanical and electrical sensor; and transmitting a connection-mode message from the machine to the monitoring device containing the status information which is outside of the normal operating parameters (Kraslavsky, col. 39 lines 20-54; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11).

17. Claims 19, 36, 38-44, 57-61, 69-71, and 76-87 have similar limitations as claims 10, 12-18, 52-56, and 72-75; therefore, they are rejected under the same rationale as discussed above.

18. In the remarks, applicant argued in substance that

(A) Applicant provides various rationales to show Kraslavsky and Cohn might not be combined together.

As to point (A), Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a monitored device (printer 4, figure 1) and a monitoring device (NTWK ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35. In addition, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11); and

transmitting the information as a message from the monitoring device to the monitored device through one or more LANs in Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is being transmitted as an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message format to communicate (transmit and receive) between Kraslavsky's monitored and monitoring devices because it would allow the message to be transferred globally between any devices.

In addition, Kraslavsky's invention is to eliminate the necessity of dedicating a personal computer to manage a peripheral such as a printer by providing an apparatus for interfacing the printer to a LAN, and to allow the peripheral to be intelligent (Kraslavsky, Field of the Invention, col. 1 lines 14-23). Therefore, combining Cohn's teaching to use Internet electronic mail to manage Kraslavsky's peripheral without dedicating a personal computer make Kraslavsky's peripheral more intelligent and enhance Kraslavsky's invention.

The test for obviousness is not whether the features of one reference may be bodily incorporated into the other reference to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art.

"(T)he proper inquiry should not be limited to the specific structure shown by the references, but should be into the concepts fairly contained therein, and the overriding question to be determined is whether those concepts would suggest one skilled in the art the modification called for by the claims", In re Bascom, 109 USPQ 98, 100 (CCPA 1956). "What appellants overlook is that it is not necessary that the inventions of the references be physically combinable to render obvious the invention under review." In re Sneed, 218 USPQ 385, 389 (CAFC 1983). "The argument that one cannot bodily incorporate the two

set of references because in one the speed of the air-fuel mixture is allegedly subsonic, whereas in the other it is sonic, is irrelevant. The test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. Rather, we look to see whether the combined teachings render the claimed subject matter obvious", In re Wood and Eversole, 202 USPQ, 171, 174 (CCPA, 1979).

The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. In re Chupp, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself. In re Eli Lilly, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the prima facie case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Although the record may establish evidence of secondary considerations which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989); Richardson-Vicks, Inc., v. The Upjohn Co., 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997) (showing of unexpected results and commercial success of claimed ibuprofen and psuedoephedrine combination in single tablet form, while supported by substantial evidence, held not to overcome strong prima facie case of obviousness).

19. The Declarations submitted by applicant on 05/11/2001 have been fully considered but they are not deemed to be persuasive as discussed above.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu, whose telephone number is (703) 305-9650. The examiner can normally be reached Monday through Friday from 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached at (703) 305-4815.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-7201 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Serial Number: 08/738,659
Art Unit: 2152

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LE HIEN LUU
PRIMARY EXAMINER

July 20, 2001